

REMARKS

Claims 1-34 remain pending in this application for which applicants seek reconsideration. Non-elected claims 16-34 have been withdrawn.

Amendment

Independent claims 1, 8, 16, and 26 have been amended to lower the upper range to 4 wt% to clearly distinguish over Patel (USP 4,224,381). Specific Examples 1, 2, and 4-6 of the present specification provide support for this change. Allowable claims 3 and 10 have been placed in independent form to place claims 3-5, 7, 10-12, and 14 in condition for allowance. In this respect, non-elected claims 18 and 28, which parallel claims 3 and 10, also have been placed in independent form. No new matter has been introduced.

Allowable Claims

Claims 3-5, 7, 10-12, and 14 have been indicated to be allowable if they are placed in independent form. In this respect, claims 3 and 10 have been placed in independent form. Although the upper range has been broadened to --to 6-- (as originally presented), instead of "less than 6," applicants submit that claims 3 and 10 are still allowable since the applied references would not have disclosed the claimed nonmagnetic underlayer composed of NiP alloy formed between the base and the soft magnetic underlayer.

Moreover, since non-elected claims 18 and 28 contain all of the elements of allowable product claims 3 and 10, they too, along with their dependent claims 19, 21, 23, 25, 29, 31, 32, and 34, are in condition for allowance. See the Rejoinder section below.

Art Rejection

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as unpatentable over Patel (USP 4,224,381). Claims 6, 8, 9, 13, and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Patel in view of Oshima (USP 6,818,031) and/or Wu (USP 6,432,562).

Applicants previously argued that independent claims 1 and 8 distinguish over Patel because the claimed upper range is less than 6 wt%, which is below the range taught by Patel. The examiner asserts that because Patel discloses "about six percent" (in column 3, lines 36-40), it would have been obvious for Patel to choose a value that is less than 6 wt%. In this respect, independent claims 1 and 8 have been amended to lower the upper range to 4 wt%.

Patel's magnetic underlayer 16 of Ni-P alloy contains phosphorous in the range of about 6 wt% to 14 wt%. Applicants submit that Patel would have taught away from lowering its lower range to 4 wt% since it explicitly calls for a specific range that is well outside the claimed range. Accordingly, applicants submit that claims 1 and 8 (as well as non-elected claims 16 and 26) patentably distinguish over Patel, Oshima, and Wu.

Rejoinder of Non-Elected Claims

As non-elected claims 16-34 contain all the elements of claims 1, 3, 8, or 10, these non-elected claims **MUST** be rejoined and allowed together with the allowed product claims. See MPEP § 821.04. As previously mentioned, claims 18, 19, 21, 23, 25, 28, 29, 31, 32, and 34 should be allowed together with allowable claims 3 and 10.

Conclusion

Applicants submit that claims 1-34 are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicants urge the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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DATE

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